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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,854	02/22/2002	Jeno Gyuris	GPCI-P02-106	2615

28120 7590 08/25/2003

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BOSTON, MA 02110-2624

EXAMINER
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WESSENDORF, TERESA D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/080,854

Applicant(s)

GYURIS ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) 1-47, 53 and 55 (in-part), 56-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-52, 53 (in-part), 54, 55(in-part) and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

Applicants pointed out and requested that the previously added claim 80 which depends on claim 48 be grouped with the elected claims 48-55. In response, claim 80, albeit made to depend on claim 48, is in actuality the non-elected and withdrawn claim 79, except termed vector instead of a construct as in claim 79.

Newly submitted claim 81 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: this claim recites a DNA element selected from inter alia, an origin of replication for a prokaryotic cell. These claimed features have not been included in any of the original claims, elected or non-elected. Furthermore, the claim covers several different species of the DNA element.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 81 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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### ***Status of Claims***

Claims 1-82 are pending in the application. Claims 81-82 have been added in the present amendment.

Claims 1-47, 53 and 55 (in-part), 56-80 (with a random peptide i.e., a library inserted in the vector as shown in the Figures) and newly added claim 81 are withdrawn from consideration.

Claims 48-52, 53 (in-part), 54, 55(in-part) and 82 are under examination.

### ***Specification***

The objection to the disclosure is withdrawn in view of the amendments to the specification incorporating the Seq. ID. Nos.

### ***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 48-55 and newly added claim 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons advanced in the last Office action.

***Response to Arguments***

Applicants argue that pages 14-30 of the specification describe "display mode" and pages 30-43 "secretion mode".

In response, a review of e.g., page 14 does not reveal any description of a mode except as literally used in the claims i.e., a "display mode".

Applicants admit that the "display" and "secretion" mode relate to a library, one skilled in the art would understand that the same description should be applied to either a vector in the context of library or a vector out of the context of a library.

In reply, applicants' arguments made it more confusing as to when the vector is to be taken in the context or out of the context of a library. Thus, the definition or clear description of what constitutes "mode" within the claimed context and in light of specification is unclear. [If mode defines a library, it is suggested that applicants amend mode to the art-recognized term "library".]

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 48-55 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Larocca et al (6,054,312) for reasons advanced in the last Office action.

***Response to Arguments***

Applicants admit that Larocca et al generally mention that the construct may include "splice donor and acceptor sites". Nevertheless, argue that Larocca fails to teach RNA splice sites flanking the coding sequence for the surface protein. It is further argued that it is well known that different locations of the splice sites can give rise to distinct vectors.

In response, since it is well known in the art that splice sites can give rise to distinct vectors, as stated, hence, Larocca would have inherently known such fact in the art of RNA splicing sites. Since Larocca is able to display and secrete the

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test peptide indicates that the RNA splices the sites that flanks the test peptide to enable its secretion.

Applicants argue that Larocca does not contemplate expression of the FGF2-3 without the surface protein as a result of the coding sequence for the surface protein being removed by RNA splicing. Larocca is argued to suggest incorporation of some DNA element useful for expression and maintenance of the construct in mammalian cells or other eukaryotic cells and describe expression of FGF-fusion phage in COS cells. It is further argued that Larocca appears to express the entire chimeric/fusion protein rather than the FGF protein alone.

In reply, applicants' arguments and the claims are contradictory. The claims recite a vector and not a protein apart from the vector. Nevertheless, attention is directed to col. 16, line 49 up to col. 17, line 50. Accordingly, Larocca fully meets the claimed vector.

No claim is allowed.

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 1-47, 53 and 55 (in-part), 56-80 (with a random peptide i.e., a library inserted in the vector as shown in the Figures) and 81 nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

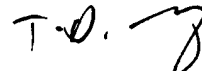
Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (703) 308-3967. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 308-7924 for regular communications and (703) 308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
T. D. Wessendorf  
Primary Examiner  
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tdw  
August 23, 2003